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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/042,583	03/17/1998	JIAN NI	PF366	5224

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EXAMINER

KAUFMAN, CLAIRE M

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/042,583

Applicant(s)

NI, ET AL.

Examiner

Claire M. Kaufman

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 February 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: see continuation sheet.

Claim(s) objected to: \_\_\_\_\_

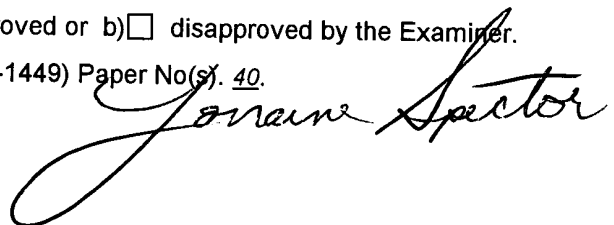
Claim(s) rejected: see continuation sheet.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 40.

10. ☐ Other: \_\_\_\_\_



Continuation of 3. Applicant's reply has overcome the following rejection(s): those relating to the cancelled claims (35 USC 112, 1st and 2nd paragraphs, and 102 and 103 as they relate to the cancelled claims only).

Continuation of 5. does NOT place the application in condition for allowance because: In brief, Applicants have misinterpreted In re Wertheim, which does not apply to the instant situation. The priority document must support what is claimed. That does not mean, in this case, that the material relied upon in the priority application must support what is claimed in the prior art patent, but what is claimed in the instant application being rejected. See MPEP 2136.03 IV. The court said "For if a patent could not therortetically have issued the day the application was filed, it is not entitled to be used against another as secret prior art." Applicants are claiming what was set forth in the 3/12/97 priority application of the '047 patent. A priority application not disclosing the subject matter claimed in a patent would not support reliance on that earliest priority date for the claimed material. A prioirty application that does disclose the same subject matter relied upon in the patent as prior art which could have been claimed and is being claimed by in the instant application, receives benefit of its filing date for effective filing date purposes under 35 USC 102(e).

7) Claims 300-318, 340-350, 374-388, 416-430, 459-475 and 595-607 are allowed.

6) claims 287-299, 319, 326-339, 351, 353-373, 389, 391-415, 431, 434-442, 446-458, 476, 478-493, 495-521, 522-531, 535-539, 541-549, 553-565, 567-594 and 608, 611-619 and 622 are rejected.

7) Claims 320-325, 352, 390, 432, 477 and 566 are objected to.

*Claw M. Katz*